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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,624	10/13/2005	Jesper Mortensen Haaning	0267us310	4465
<div>69987 7590 01/28/2010 BAYER HEALTHCARE LLC Law & Patents 800 Dwight Way BERKELEY, CA 94710</div>				
EXAMINER				
ROBINSON, HOPE A				
ART UNIT		PAPER NUMBER		
1652				
MAIL DATE		DELIVERY MODE		
01/28/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,624

Applicant(s)

HAANING ET AL.

Examiner

HOPE A. ROBINSON

Art Unit

1652

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 7, 13, 14, 25-28, 30, 32, 35, 50, 51, 53-55, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) 51, 53, 54, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 13, 14, 25-28, 30, 32, 35, 50 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Application Status

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 9, 2009 has been entered.

Claim Disposition

2. Claims 1-2, 7, 13-14, 25-28, 30, 32, 35, 50-51, 53-55 and 62-63 are pending. Claims 1-2, 7, 13-14, 25-28, 30, 32, 35, 50 and 55 are under examination. Claims 51, 53-54 and 62-63 are withdrawn from further consideration pursuant to 37 CFR 1.12(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is

most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 7, 13-14, 25-28, 30, 32, 35, 50 and 55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention is directed to an isolated FVII or FVIIa variant comprising a sequence which differs from human FVII or FVIIa (SEQ ID NO:1), in no more than 15 amino acid residues and wherein the structure has the modification of L65Q. The claims can be construed as open, based on the open language "comprising", thus the recited "in no more than 15 amino acid residues" is not limited to 15 modifications. With the recited modification at position L65Q, claim 1 can be construed as having at least 16 modifications. Note also that dependent claim 2 recites 18 modifications (see also claim 35 with 30 modifications). Therefore, the claimed invention contemplates more than 15 modifications.

In addition, the instant specification does not provide support for the aforementioned amendatory language. At paragraph [0083] the specification discloses that, "A 'variant' is a polypeptide, which differs in one or more amino acid residues from its parent polypeptide, normally in 1-15 amino acid residues (e.g. in 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14 or 15 amino acid residues), such as in 1-10 amino acid residues, e.g. in 1-8, 1-6, 1-5 or 1-3 amino acid residues. Normally, the parent polypeptide is

hFVII or hFVIIa. Thus, a 'variant' typically contains 1-15 amino acid modifications (for example 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14 or 15 amino acid modifications), such as 1-10 amino acid modifications, e.g. 1-8, 1-6, 1-5 or 1-3 amino acid modifications relative to the parent polypeptide". Clearly the invention is drawn to a genus of structures not adequately described.

The specification fails to provide any additional representative species of the claimed genus to show that applicant was in possession of the claimed genus. A representative number of species means that the species which are adequately described are representative of the entire genus. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, disclosure of drawings, or by disclosure of relevant identifying characteristics, for example, structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus.

Moreover, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir.1991), states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in *possession of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*" (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (See *Vas-*

Cath at page 1116). The skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore, conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. *See Fiers v. Revel, 25 USPQ2d 1601 at 1606 (CAFC 1993)*.

Therefore, for all these reasons the specification lacks adequate written description, and one of skill in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 2 and 35 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter, which applicant (s) regard as their invention.

Claims 2 and 35 are indefinite because the claims lack clear antecedent basis, since claim 1 recites "in no more than 15 amino acid residues" which was intended to limit the number of modifications in the structure and dependent claims 2 and 35 recite over 15 modifications.

Conclusion

5. No claims are presently allowable. The mutation L65Q in (SEQ ID NO:1) is free of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hope A. Robinson/

Primary Examiner, Art Unit 1652

